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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,606	01/22/2001	Hiroshi Nojiri	202135US0	9738

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EXAMINER	
WELLS, LAUREN Q	
ART UNIT	**PAPER NUMBER**
1617	17

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/765,606	Applicant(s) NOJIRI ET AL.	
	Examiner Lauren Q Wells	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 March 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-6 and 12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claims 1, 3-6 and 12 are pending. The Amendment filed 3/10/03, Paper No. 12, cancelled claims 2, 7-11 and 13-14, and amended claims 1 and 3.

Applicant's arguments with respect to claims 1, 3-6 and 12 have been considered but are moot in view of the new ground(s) of rejection.

On pages 2-4 of the Amendment filed 3/10/03, Paper No. 12, it appears that Applicant is attempting to demonstrate unexpected results. The Examiner respectfully directs Applicant to the guidelines for showing unexpected results. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/03 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 12 is vague and indefinite, as it is confusing. How can component (B) be selected from oils, when component (B) is an alcohol?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3-4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al. (JP 122424/1997) in view of Tada (JP 410036247).

The instant invention is directed toward a cosmetic composition comprising arginine and an alcohol selected from vetiverol, patchouli alcohol, guaiol, cedrol, and mixtures thereof.

Shoji et al. teach a cosmetic for improving rough skin, improving suppleness of skin, improving resiliency, improving face color, decreasing wrinkle formation, and decreasing spots and freckles. The composition comprising a copolymer, and amino acids or vegetable extracts, or combinations thereof. Arginine is taught as a preferred amino acid comprising 0.0001-15%

of the composition. The vegetable extracts are taught as comprising 0.0001-20% of the composition. The reference lacks a sesquiterpene alcohol. See pages 2-4, 6-9.

Tada et al. teach a composition comprising cetrol for preventing freckle formation. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the composition of Shoji et al. and Tada et al. because it is obvious to combine two compositions taught by the prior art to be useful for the same purpose to form a third composition that is to be used for the very same purpose. In re Kerkoven, 205 USPQ 1069 (CCPA 1980). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the two compositions because of the expectation of achieving a composition with enhanced effectiveness against freckle formation.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoji et al. in view of Tada et al. as applied to claims 1, 3-4 and 12 above, and further in view of Herstein (5,616,332).

Shoji et al. and Tada et al. are applied as discussed above. The references do not teach pH.

Herstein teaches skin cosmetic compositions. The reference teaches that consumer use, over the counter preparations intended for daily or twice daily application should be relatively mild, with a pH of from about 4.5 to about 6.0. See Col. 7, lines 1-5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the composition of the combined references as having a pH between 4.5 and 6 because of the expectation of achieving a composition that is over-the-counter and can be applied

multiple times per day. Furthermore, it is respectfully pointed out that it is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. In re Boesch, 205 USPQ 215 (CCPA 198). It would have been obvious for one skilled in the art to vary the proportions of components in a composition to arrive at the best compositions for the intended purpose. "It is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Only if the "results optimizing a variable" are "unexpectedly good" can a patent be obtained for the claimed critical range. In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977); see also In re Dillon, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc). Absent evident of unexpected results, the pH of the composition is not given patentable weight over the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
May 26, 2003

SREENI PADMANABHAN
PRIMARY EXAMINER

6/1/03